

Appl. No.: 10/615,417
 Amendment dated September 16, 2005
 Non-Final Office Action dated Aug. 19, 2005

REMARKS

This Amendment and Response is presented in response to the Examiner's Office Action mailed on August 19, 2005. A response is due within the shortened time period of November 19, 2005.

Claims 1, 12, 15-16, 39, 41, 45, 50, 51, 57, 58, 63, and 74 are currently amended.

Claims 5-8, 11, 13-14, 17-21, 24-33, 42, 44, 48, 59-62, 68-69, and 77 are cancelled.

New Claims 78-135 have been added.

Claims 1-4, 9-10, 12, 15-16, 22-23, 34-41, 43, 45-47, 49-58, 63-67, 70-76, and 78-135 are pending in the application.

Applicants acknowledge, with appreciation, the Examiner's indication that claims 34-38 are allowed. Applicants further acknowledge, with appreciation, the Examiner's indication that claims 13-23, 25, 26, 28-33, 44, 45, 47-56, 60, 63, 64 and 67-77 would be allowable if rewritten in independent form.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have amended claim 1 to incorporate the limitations of claims 11 and 13 in view of the Examiner's indication that claim 13, which is dependent from claim 11 and includes the limitations thereof, is directed to allowable subject matter.

Claim 12 has been amended for the reasons discussed in Section III below.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have cancelled claims 24-33 without prejudice.

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Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have amended claim 39 to incorporate the limitations of claim 44 in view of the Examiner's indication that claim 44 is directed to allowable subject matter.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have amended claim 57 to incorporate the limitations of claim 60 in view of the Examiner's indication that claim 60 is directed to allowable subject matter.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have added new claim 78, and dependent claims thereto, which incorporates the limitations of claims 1, 11 and 15, in view of the Examiner's indication that claim 15 is directed to allowable subject matter.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have added new claim 96, and dependent claims thereto, which incorporates the limitations of claims 1, 11 and 16, in view of the Examiner's indication that claim 16 is directed to allowable subject matter.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have added new claim 104, and dependent claims thereto, which incorporates the limitations of claims 1 and 22, in view of the Examiner's indication that claim 22 is directed to allowable subject matter.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have added new claim 111, and dependent claims thereto, which incorporates the limitations of claims 1 and 23, in view of the Examiner's indication that claim 23 is directed to allowable subject matter.

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Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have added new claim 118, and dependent claims thereto, which incorporates the limitations of claims 39, 46 and 47, in view of the Examiner's indication that claim 47 is directed to allowable subject matter.

Without addressing, or acquiescing to, the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have added new claim 121, and dependent claims thereto, which incorporates the limitations of claims 57, 61 and 63, in view of the Examiner's indication that claim 63 is directed to allowable subject matter.

Paragraph [0068] of the application as published was corrected as discussed in Section I below to overcome the Examiner's objection to informalities.

Reconsideration of the currently pending claims on file in this application is respectfully requested in view of the above amendments to the specification and claims, and further in view of the following remarks, which are directed to Applicants' inventions defined in the claims currently presented.

I. OBJECTIONS TO THE SPECIFICATION

The Examiner has objected to the disclosure for having informalities.

With respect to the Examiner's first objection regarding the use of "bearing element" and "bearing surface," Applicants respectfully direct the Examiner to Figures 4 and 15 which show two embodiments of the inventive concept taught by Applicants in the specification. As evidenced from the figures, the device includes a pair of bearing elements (38, 52 in FIG. 4 and 80, 130 in FIG. 15). Each of the bearing elements have a corresponding "bearing surface" (40 in FIG. 11; 54 in FIG. 9; 80 in FIG. 18, 132 in FIG. 15). Persons of skill in the art would understand the use of "bearing element" and "bearing surface" in view of the disclosure and figures that accompany the disclosure. Therefore, Applicants request that the Examiner withdraw this objection to the specification.

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With respect to the Examiner's objection regarding the use of "bearing element" with respect to element 52 and 54, Applicants were unable to locate the reference the Examiner has cited at page 12, lines 11-12. Applicants did, however, find a reference to "bearing element 54" at page 16, line 11, and has amended the specification to correct that informality. Accordingly, Applicants request that the Examiner withdraw this objection to the specification.

II. REJECTION UNDER 35 U.S.C. §102(B)

The Examiner has rejected claims 1-12, 24, 27, 39-43, 46, 57-59, 61, 62, 65 and 66 under 35 U.S.C. §102(b) as being anticipated by Senegas (WO 01/28442 A1) for allegedly patenting or describing in a printed publication Applicants' invention more than a year prior to the date of the application (Office action, page 3). Senegas WO 01/28442 A1 entered the U.S. National Stage as Application No 10/110,841 on July 11, 2002, which issued as U.S. Patent 6,761,720 issued July 13, 2004 (previously cited by Applicants).

As discussed above, without acquiescing to the merits of the Examiner's rejection, and in a bona fide attempt to advance this application to issuance, Applicants have amended the claims to overcome this rejection in view of the Examiner's indication of allowable subject matter.

III. Rejection Under 35 U.S.C. §101

The Examiner has rejected claim 12 under 35 U.S.C. §101 as drawn to non-statutory subject matter (Office Action, page 2). The Examiner argues that claim 12 "positively recites part of a human, i.e., 'attachment mechanism traverses a midline of the vertebra. Thus claim 12 includes a human *within its scope* and are non-statutory." The Examiner relies on *Application of Wakefield* to support his rejection.

Applicants do not believe that the claim as written "positively recites a human body." Rather, the claim, as written, describes the attachment mechanism with reference to an anatomical portion of the vertebra. Further, nothing in *Application of Wakefield*, which is directed to a rejection under §112 for presentation of a large number of claims and based on the Examiner's assertion that

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synthetic rubber includes purified natural rubber, precludes Applicants from obtaining the claim as presented.

Without waiving Applicants' objection to the Examiner's ground for rejection, Applicants have amended claim 12 to recite that the attachment mechanism "is adapted and configured to traverse a midline" in an effort to clarify Applicants' intent to claim the device and not the human body. In view of Applicants' amendment, Applicant requests the Examiner withdraw his rejection of claim 12 under 35 U.S.C. §101 as being drawn to non-statutory subject matter.

IV. CLAIM OBJECTIONS

The Examiner has objected to claims 13-23, 25, 26, 28-33, 44, 45, 47-56, 60, 64 and 67-77 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. In view of Applicants' amendments presented, Applicants request the Examiner withdraw his objections and advance any pending claims that were previously objected to issuance.

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CONCLUSION

For the foregoing reasons, Applicants request the Examiner allow claims 1-4, 9-10, 12, 15-16, 22-23, 34-41, 43, 45-47, 49-58, 63-67, 70-76, and 78-135 and advance the application to issuance.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. 23-2415 (Docket No. 29914-703.201).

Respectfully submitted,

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By



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